

### REMARKS

In the Office Action dated January 5, 2006, claims 1, 3-9, and 12-29 were rejected under 35 U.S.C. § 103 over U.S. Patent No. 6,894,994 (Grob) in view of U.S. Patent Application Publication No. 2002/0057653 (Dolan).

It is respectfully submitted that a *prima facie* case of obviousness has not been established with respect to the claims over the asserted combination of Grob and Dolan, for at least the following reason: no motivation or suggestion existed to combine the teachings of the references. *See* M.P.E.P. § 2143 (8<sup>th</sup> ed., Rev. 3), at 2100-135.

With respect to claim 1, the Office Action conceded that Grob fails to disclose the following element of claim 1: in response to determining that the handoff is required, sending a message from the first base station to the second base station, the message indicating to the second base station that handoff is required. 1/5/2006 Office Action at 2. The Office Action, however, relied upon Dolan as disclosing the claim element that is missing from Grob. *Id.* Specifically, the Office Action pointed to Fig. 6 of Dolan, which shows a source base station sending a source transfer request to an MSC, which in turn forwards the source transfer request to a target base station, for the purpose of performing a handoff.

It is respectfully submitted that a person of ordinary skill in the art would not have been motivated to modify the handoff mechanism taught by Grob with the mechanism disclosed by Dolan to achieve the claimed subject matter. Although Grob states that handoffs between CDMA and HDR systems are possible, the handoff performed in Grob is quite different from the handoff performed according to claim 1. As discussed in Grob, when an access terminal 110 is near an edge of the coverage area of an HDR access point 120, the access point 120 can signal the access terminal 110. Grob, 24:27-29. This causes the access terminal 110 to search for both an HDR system access point 120 and CDMA base station. Grob, 24:29-32. If a CDMA pilot is detected by the access terminal 110, then the air link can be handed from the HDR system to the CDMA system, "for example, in a manner similar to the handoff between IS-95 and AMP systems." Grob, 24:32-35.

Thus, what is contemplated by Grob is that a base station of a first type has to notify the access terminal (not the base station of the other type) that handoff may be required, which causes the access terminal to search for available HDR and CDMA base stations. Clearly, Grob

does not disclose or suggest base stations of different types sending a message between each other to indicate that handoff is required.

Recognizing this deficiency of Grob, the Office Action turned to Dolan in an attempt to address the deficiencies of Grob. However, it is clear from the teachings of Dolan that its handoff is performed in the context of base stations that operate according to the same wireless communications protocol, such as CDMA. There is absolutely no teaching or suggestion in Dolan that its source base station and target base station (as depicted in Fig. 6 as well as in the other figures) are of different types. A person looking to the teachings of Dolan would thus not have been motivated to apply its teachings to the handoff mechanism of Grob.

Moreover, the Office Action is proposing a modification of the Grob handoff mechanism that would significantly change the principle of operation of the Grob. "If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious." M.P.E.P. § 2143.02, at 2100-138. Here, as noted above, the handoff mechanism disclosed by Grob involves a base station of a first type notifying an access terminal (not the base station of the other type) that handoff may be required, which causes the access terminal to search for available HDR and CDMA base stations. Modifying the Grob system based on the teachings of Dolan would significantly change the principle of operation of the handoff mechanism of Grob, which is a clear indication that no motivation or suggestion existed to combine Grob and Dolan.

In view of the foregoing, it is respectfully submitted that a *prima facie* case of obviousness has not been established with respect to claim 1.

Independent claims 16 and 24 are allowable for similar reasons.

Dependent claims, including newly added dependent claims 30-32, are allowable for at least the same reasons as corresponding independent claims.

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Allowance of all claims is respectfully requested. The Commissioner is authorized to charge any additional fees and/or credit any overpayment to Deposit Account No. 20-1504 (NRT.0103US).

Respectfully submitted,

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